

REMARKS

This Amendment is submitted in response to the Office Action dated April 20, 2006, having a shortened statutory period set to expire July 20, 2006. Proposed amendments to the Claims include amending Claims 1, 3-7, 9-10, 12, 14-17 and 19, and canceling Claims 2, 8, 11, 13 and 18. Upon entry of the proposed amendments, Claims 1, 3-7, 9-10, 12, 14-17 and 19 will now be pending.

REJECTIONS UNDER 35 U.S.C. § 112

In paragraph 4 of the present Office Action, Claim 10 is rejected under 35 U.S.C. § 112, second paragraph, for the use of the terms “first processes” and “second processes,” which are confusing to the Examiner. These terms have been removed by the present amendment, and thus the rejection is moot. Claim 10 is also rejected under 35 U.S.C. § 112, first paragraph, as being a “single means claim.” Claim 10 is a computer program product claim that lacks any “means” language, and thus a “single means” rejection appears to be inappropriate. Note that Applicants have further amended Claim 10 to include allowable features from originally filed Claim 11. Claim 10 also now includes the Examiner-suggested preamble regarding a “computer-readable medium.” Applicants therefore request that these rejections be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 101

In paragraph 8 of the present Office Action, Claims 1-3, 7-8, 10-13 and 17-19 are rejected under 35 U.S.C. § 101. Applicants respectfully traverse this rejection.

In paragraph 10, the Examiner states that Claims 1-3 and 7-8 consist “solely of methods without practical application and tangible result in the technological arts or simply manipulate abstract ideas without practical application in the technological arts.” Applicants respectfully traverse this rejection.

First, the Examiner has failed to meet his burden in producing a *prima facie* showing of a lack of utility per Section 101. As stated in Section 2107.02(IV) of the MPEP, a “*prima facie*” showing must be set forth in a well-reasoned statement. Any rejection based on lack of utility should include a detailed explanation why the claimed invention has no specific and substantial credible utility. Whenever possible, the examiner should provide documentary evidence

regardless of publication date (e.g., scientific or technical journals, excerpts from treatises or books, or U.S. or foreign patents) to support the factual basis for the *prima facie* showing of no specific and substantial credible utility. If documentary evidence is not available, the examiner should specifically explain the scientific basis for his or her factual conclusions.” Examiner’s sole statement that “Claims 1-3, and 7-8 consist solely of methods without practical application and tangible result in the technological arts or simply manipulate abstract ideas without practical application in the technological arts” fails to meet Examiner’s burden for “the *prima facie* showing of no specific and substantial credible utility.”

Second, under Section 2107(II)(B)(1) of the MPEP, “If the applicant has asserted (in the supporting written specification) that the claimed invention is useful for any particular practical purpose (i.e., it has a ‘specific and substantial utility’) and the assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility.” The Examiner’s attention is directed to Page 5, lines 21 *et seq.* of the originally filed specification, which states:

The invention is directed to a method for language-verification of a Java card CAP file, which has been converted from an original Java code file under conservation of its original Java semantics. In a conversion step the Java card CAP file is converted into a corresponding converted Java code file that is semantically identical to the Java card CAP file. In a language verification step, the converted Java code file is then verified concerning its adherence to Java language specifications. **This advantageously provides that a standard tool for language verification can be used, more particularly the verification tool that can be used for language verifying the original Java code file, even more particularly the Java virtual machine.** Furthermore the use of a known Java language verification process exhibits the advantage that it has already been tested and corrected with view to programming errors and that the known process therefore exhibits a much lower number of possible errors than a new process for directly verifying Java card CAP files for their compliance with Java card language rules would have. The invention relies on the experience that has made the language verification of an original Java code file relatively secure and unproblematic. **(Emphasis added.)**

Thus, even the features of exemplary Claim 1, without the additional amended features from originally filed Claim 2, show that the steps of “conversion” and “verifying” have the utility of using a “standard tool for language verification.”

Third, Applicants respectfully direct the Examiner’s attention to Section (IV)(C)(2)(b) of the USPTO’s October 26, 2005 “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility.” As stated on Page 20 of this guide, “In determining whether the claim is for a ‘practical application,’ the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is ‘useful, tangible and concrete.’” (Emphasis in original.) Thus, all of the elements in the Claim must be considered, NOT just one (such as the “language-verification step”).

As presently amended, Claim 1 describes a final result of “replacing...externally defined names with original names by using a mapping scheme between Java names and tokenized identifiers, to obtain the converted Java code file for said language-verification step.” This result is “useful, tangible and concrete.” The claimed invention is “useful” since, *inter alia*, it provides a method to make “language verification of an original Java code file relatively secure and unproblematic” (present disclosure, Page 5, lines 3-4). The claimed invention is “tangible” since it produces a result that is not “abstract.” Rather, specific files are replaced in the mapping substep. (See Section (IV)(C)(2)(b)(2) of the USPTO’s October 26, 2005 “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility.”) The claimed invention is “concrete” since, on the claim’s face, it presents a repeatable and predictable set of steps and results. (See Section (IV)(C)(2)(b)(3) of the USPTO’s October 26, 2005 “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility.”)

In paragraph 11 of the present Office Action, the Examiner has rejected Claims 10-13 and 17-19 under Section 101 for consisting solely of a “system of (sic) software program per se.” It is Applicants understanding that this rejection is based on the lack of a tangible medium in the computer program product Claims 10-13. These claims have now been amended to include this feature. Regarding Claims 17-19, Applicants now amend these claims to be similarly directed to a computer readable medium on which a computer program product is stored. Thus, these rejections should be withdrawn.

ALLOWABLE CLAIMS

In paragraph 28 of the present Office Action, the Examiner has indicated that Claims 2, 8, 11, 13 and 18 would be allowed if rewritten in independent form to include all limitations of their respective base claims. The present invention does this. Assuming that the Section 101 rejections are withdrawn, the presently amended claims should be allowed.

CONCLUSION

Having complied with the suggestions of the Examiner, Applicants now respectfully request a Notice of Allowance for all pending claims. If the Examiner believes that a teleconference would be useful in promoting any or all of the present claims to allowance, such a telephone call to the Applicant's undersigned representative, at 512.617.5533, would be greatly appreciated.

No extension of time for this response is believed to be necessary. However, in the event an extension of time is required, that extension of time is hereby requested. Please charge any fee associated with an extension of time as well as any other fee necessary to further the prosecution of this application to **IBM CORPORATION DEPOSIT ACCOUNT No. 09-0461**.

Respectfully submitted,



James E. Boice
Registration No. 44,545
DILLON & YUDELL LLP
8911 North Capital of Texas Highway
Suite 2110
Austin, Texas 78759
512.617.5533

ATTORNEY FOR APPLICANT(S)